



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Desnoyers et al.
Appl. No. : 10/036,041
Filed : December 26, 2001
For : NOVEL NUCLEIC ACIDS
ENCODING PEPTIDES THAT
INDUCE CHONDROCYTE
REDIFFERENTIATION
Examiner : Jiang, Dong
Group Art Unit : 1646

**APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705**

United States Patent and Trademark Office
P.O. Box 2327
Arlington, Virginia 22202

Dear Sir:

Applicant respectfully requests reconsideration of the Patent Term Adjustment indicated in the *Notice of Allowance* mailed on April 26, 2005 for the above-identified patent application. This application for Patent term adjustment is being filed with payment of the Issue Fee for this application.

Applicant respectfully submits that the correct patent term adjustment for the patent that issues from this application is 272 days, not 15 days as indicated on the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) that was mailed with the Notice of Allowance. Applicants' corrected PTA calculation is based in part upon the projected issue date of the patent on November 1, 2005, which is "the Tuesday before the date that is 28 weeks ... after the mailing date of the [Determination of Patent Term Adjustment under 35 U.S.C. 154(b)]." A complete

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calculation summary with the relevant dates and rules is submitted herewith as **PTA Calculation Exhibit 1**.

§ 1.705(b)(1)

This Application for Patent Term Adjustment is accompanied by the \$200 fee as set forth in § 1.18(e). The fee is identified on the Transmittal Letter accompanying the payment of the Issue Fee and is included as part of the Issue Fee payment.

§ 1.705(b)(2)

As mentioned above and in accordance with 37 C.F.R. § 1.705(b)(2)(i), Applicants submit that the correct Patent Term Adjustment for this application is 272 days.

In accordance with 37 C.F.R. § 1.705(b)(2)(iii), Applicants state that no patent granted on this application is subject to a terminal disclaimer.

In accordance with 37 C.F.R. § 1.705(b)(2)(ii), Applicants are entitled to the following adjustments (credits):

- *§ 1.703(a)(1)/14-Month PTO first Action*: The application was filed on December 26, 2001. The first action was mailed by the PTO on March 20, 2003. Applicants are entitled to a **credit of 22 days**.
- *1.703(b)/3-Year PTO Issue of Patent*: The application was filed on December 26, 2001. The projected issue date is November 1, 2005. The projected date is “the Tuesday before the date that is 28 weeks ... after the mailing date of the [Determination of Patent Term Adjustment under 35 U.S.C. 154(b)].” Based upon the assumption that the patent will issue on the projected date, Applicants are entitled to a **credit of 310 days**.

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Applicants note that the PTO's Patent Term Adjustment History available on PAIR does not include an application/calculation based upon the 3-year from filing issue rule. Applicants have included the calculation here in the interest of raising all issues that can be raised as required under § 1.705(d).

- *1.703(a)(2),(3)/4-Month PTO Response to Applicant Reply*: The PTO received Applicants reply to non-final Office Action on September 3, 2004. The PTO mailed the Notice of Allowance on April 26, 2005. As discussed more fully below, the Supplemental Amendment received by the PTO on November 24, 2004 was expressly requested by the Examiner. Therefore, no reduction in term is appropriate per § 1.704(c)(8). Applicants are entitled to a **credit of 113 days**.

THE SUM OF THE ABOVE LISTED CREDIT DAYS IS: 445 DAYS

In accordance with 37 C.F.R. § 1.705(b)(2)(iv)(A), Applicants are subject to the following reductions (debits):

- *1.704(b)/3-Month Applicant Response to Notice or Action*: The PTO mailed a non-final Office Action on March 20, 2003. The PTO received Applicants' response on June 24, 2003. Applicants are subject to a **debit of 4 days**.
- *1.704(b)/3-Month Applicant Response to Notice or Action*: The PTO mailed a non-final Office Action on August 21, 2003. The PTO received Applicants' response on November 24, 2003. Applicants are subject to a **debit of 3 days**.
- *1.704(c)(8)/Supplemental Reply or IDS*: The PTO received Applicants' response on May 24, 2004. The PTO received Applicants' IDS on June 24, 2004. The IDS was not expressly requested by the Examiner. Applicants are subject to a **debit of 31 days**.

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THE SUM OF THE ABOVE LISTED REDUCTIONS IS: 38 DAYS

In accordance with 37 C.F.R. § 1.705(b)(2)(iv)(B), Applicants state that there are no other circumstances constituting a failure to engage in reasonable efforts. Applicants note that the PTO's Patent Term Adjustment History available on PAIR shows an additional reduction of 82 days, presumably because Applicants filed a Supplemental Response, which was received by the PTO on November 24, 2004. Based upon that, the PTO calculated a reduction of 82 days under § 1.704(c)(8). However, no reduction is appropriate in this case because the Supplemental Response was expressly requested by the Examiner. The Examiner contacted Applicants' representative and offered to allow the case if certain claims were cancelled. Applicants authorized the cancellation of the claims, and at the express request of the Examiner, filed a Supplemental Response, which was received by the PTO on November 24, 2004. Therefore, the filing of the Supplemental Response does not constitute a failure to engage in reasonable efforts per § 1.704(c)(8) because it was filed at the express request of the Examiner. Accordingly, Applicants request reinstatement of the 82 day reduction made by the PTO.

Based upon the above information, Applicants submit that the following is the correct Patent Term Adjustment:

	Reductions	Credits
Total Reductions and Credit Days	38	445
Overlap Days		113
Net Reductions and Credit Days	38	310*
Net Patent Term Adjustment Days (310-38)		272

*The net credit Days were limited by 37 C.F.R. § 1.703(f), "Actual Delay Limitation. See the calculation at the end of the attached **PTA Calculation Exhibit 1**.

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Conclusion

Applicants request reconsideration of the patent term adjustment sent with the Notice of Allowance. For the reasons discussed above, the correct Patent Term Adjustment is 272 days, and not 15 days as determined by the PTO.

Please direct any question regarding this request to the undersigned attorney of record at 619-687-8656 or at the general office telephone number set forth below.

The undersigned authorizes the Commissioner to charge any additional fees required by this paper or to credit any overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 22, 2005

By: M. T. Morley
Marc T. Morley
Registration No. 52,051
Attorney of Record
Customer No. 30,313
619-235-8550

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PTA Calculation Exhibit 1

RULE APPLICATION SUMMARY				
Event	Rule Invoked	Related Event	Excluded Days	Debit Credit Days
A 12/26/2001 Filing Date under 35 USC 111(a) (US National Application)	14-Month PTO First Action PTO must mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 not later than 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 in an international application. Period of adjustment (credits) begins on the day after the date that is 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 and ending on the date of mailing of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(1)(A)(i); 37 CFR 1.702(a)(1), 1.703(a)(1).	<i>First PTO Action:</i> 03/20/2003 Non-final Action	0	22
B 12/26/2001 Filing Date under 35 USC 111(a) (US National Application)	3-Year PTO Issue of Patent PTO must issue a patent within 3 years (not including exclusions) after the date on which the application was filed under 35 USC 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application. Period of adjustment (credits) begins on the day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the listed exclusionary periods. 35 USC 154(b)(1)(B); 37 CFR 1.702(b), 1.703(b).	<i>Issue Date:</i> 11/01/2005 Issue Date	0	310

C	03/20/2003 Non-final Action	<p><u>3-Month Applicant Response to Notice or Action</u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. <u>35 USC 154 (b)(2)(C)(ii)</u>; <u>37 CFR 1.704(b)</u>.</p>	<p><i>Applicant Response:</i></p> <p>06/24/2003 Reply after Non-final Action under 37 CFR 1.111</p>	0	4	0	
D	06/24/2003 Reply after Non-final Action under 37 CFR 1.111	<p><u>4-Month PTO Response to Applicant Reply</u></p> <p>PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credits) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. <u>35 USC 154(b)(1)(A)(ii)</u>; <u>37 CFR 1.702(a)(2)</u>, <u>1.703(a)(2)</u>, (3).</p>	<p><i>PTO Response:</i></p> <p>08/21/2003 Non-final Action</p>	0	0	0	
E	08/21/2003 Non-final Action	<p><u>3-Month Applicant Response to Notice or Action</u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was</p>	<p><i>Applicant Response:</i></p> <p>11/24/2003 Reply after Non-final Action under 37 CFR 1.111</p>	0	3	0	

		filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. <u>35 USC 154 (b)(2)(C)(ii)</u> ; <u>37 CFR 1.704(b)</u> .				
F	11/24/2003 Reply after Non-final Action under 37 CFR 1.111	<u>4-Month PTO Response to Applicant Reply</u> PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credits) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. <u>35 USC 154(b)(1)(A)(ii)</u> ; <u>37 CFR 1.702(a)(2)</u> , <u>1.703(a)(2)</u> , (3).	<i>PTO Response:</i> 02/25/2004 Non-final Action	0	0	0
G	02/25/2004 Non-final Action	<u>3-Month Applicant Response to Notice or Action</u> Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. <u>35 USC 154 (b)(2)(C)(ii)</u> ; <u>37 CFR 1.704(b)</u> .	<i>Applicant Response:</i> 05/24/2004 Reply after Non-final Action under 37 CFR 1.111	0	0	0
H	05/24/2004 Reply after Non-final Action under 37 CFR 1.111	<u>4-Month PTO Response to Applicant Reply</u> PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credits) begins on the day after	<i>PTO Response:</i> 08/02/2004 Non-final Action	0	0	0

		the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. <u>35 USC 154(b)(1)(A)(ii); 37 CFR 1.702(a)(2), 1.703(a)(2),(3).</u>				
I	06/24/2004 Information Disclosure Statement	<u>Supplemental Reply or Other Paper (IDS)</u> Period of adjustment (credits) shall be reduced where applicant submits a supplemental reply or other paper, not expressly requested by the examiner, after a reply has been filed, for the period beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed. <u>37 CFR 1.704(c)(8).</u>	<i>Initial Reply:</i> 05/24/2004 Reply after Non- final Action under 37 CFR 1.111	0	31	0
J	08/02/2004 Non-final Action	<u>3-Month Applicant Response to Notice or Action</u> Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. <u>35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</u>	<i>Applicant Response:</i> 09/03/2004 Reply after Non- final Action under 37 CFR 1.111	0	0	0
K	09/03/2004 Reply after Non- final Action under	<u>4-Month PTO Response to Applicant Reply</u> PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed.	<i>PTO Response:</i> 04/26/2005 Notice of	0	0	113

37 CFR 1.111	The period of adjustment (credits) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. <u>35 USC 154(b)(1)(A)(ii)</u> ; <u>37 CFR 1.702(a)(2)</u> , <u>1.703(a)(2)</u> , (3).	Allowance under 35 USC 151			
L 11/24/2004 Supplemental Applicant Response	<p><u>Supplemental Reply or Other Paper</u></p> <p>Period of adjustment (credits) shall be reduced where applicant submits a supplemental reply or other paper, not expressly requested by the examiner, after a reply has been filed, for the period beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed. <u>37 CFR 1.704(c)(8)</u>.</p> <p>The supplemental reply was expressly requested by the examiner. Therefore, no debits are generated under this rule.</p>	<p><i>Initial Reply:</i></p> <p>09/03/2004 Reply after Non-final Action under 37 CFR 1.111</p>	0	0	0
M 04/26/2005 Notice of Allowance under 35 USC 151	<p><u>3-Month Applicant Response to Notice or Action</u></p> <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. <u>35 USC 154 (b)(2)(C)(ii)</u>; <u>37 CFR 1.704(b)</u>.</p>	<p><i>Applicant Response:</i></p> <p>07/22/2005 Issue Fee Payment under 35 USC 151</p>	0	0	0

N 07/22/2005 Issue Fee Payment under 35 USC 151	4-Month PTO Issue of Patent PTO must issue a patent not later than 4 months after the date on which the issue fee was paid under 35 USC 151 and all outstanding requirements were satisfied. The period of adjustment (credits) begins on the day after the date that is 4 months after the date the issue fee was paid and all outstanding requirements were satisfied and ends on the day the patent issues. 35 USC 154(b)(1)(A)(iv); 37 CFR 1.702(a)(4), 1.703(a)(6).	Issue Date: 11/01/2005 Issue Date	0	0	0
Total Exclusion, Debit, and Credit Days			0	38	445
Overlap Days			0	0	113
Net Exclusion, Debit, and Credit Days			0	38	310†
Net Patent Term Adjustment Days					272
†Net credits were limited by 37 CFR § 1.703(f) "Actual Delay" limitation. See calculation below.					

37 CFR § 1.703(f) "ACTUAL DELAY" CALCULATION			
	Credit Days During Exclusionary Periods	Credit Days During Non-Exclusionary Periods	
		Three-Year Issue Guarantee	All Other Rules
Net Credit Days	0	310	135
Maximum Credit Days under 37 CFR § 1.703(f) "Actual Delay" Limitation		310	

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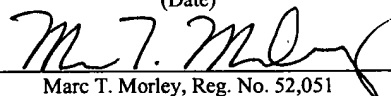
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Group Art Unit : 1646

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

July 22, 2005

(Date)


Marc T. Morley, Reg. No. 52,051

SUMMARY OF INTERVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted in order to summarize the telephonic interview between Applicants representative and the Examiner on July 18, 2005.

Summary of Interview begins on page 2 of this paper.

Remarks begin on page 3 of this paper.

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Filed : December 26, 2001

SUMMARY OF INTERVIEW

The following is a summary of the telephone interview held on July 18, 2005. Applicant's representative, Marc Morley, and Patent Office representative, Examiner Jiang participated in the interview. Applicant first wishes to thank Examiner Jiang for accommodating the interview.

Exhibits and/or Demonstrations

No exhibits or demonstrations were presented during the interview.

Identification of Claims Discussed

No claims were discussed.

Identification of Prior Art Discussed

No prior art was discussed.

Proposed Amendments

No amendments were proposed.

Principal Arguments and Other Matters

The parties discussed the status of the Examiner's initials on a form PTO-1449 received by the Office on June 24, 2004. In particular, Applicants representative sought confirmation that all references had been considered and were initialed by the Examiner.

Results of Interview

The Examiner indicated that all references, including the third listed reference had been considered. The Examiner agreed to send another copy of the form PTO-1449 clearly showing the Examiner's initials by each reference. The Examiner faxed a courtesy copy of the Interview Summary on Thursday, July 21, 2005.

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REMARKS

This paper is being filed within one month of the interview date and provides a statement of the substance of the interview held on July 18, 2004. This Summary is submitted in order to satisfy Applicants' obligation to provide a formal written summary of substance of the interview held on July 18, 2005 (*see* M.P.E.P. § 713.04). The purpose of the interview was to clarify the status of the Examiner's initials on a previously filed form PTO-1449. As discussed above, the Examiner noted that all references were considered and initialed.

Conclusion

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 22, 2005

By: M.T. Morley

Marc T. Morley
Registration No. 52,051
Attorney of Record
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